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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte ROBERT TOMASSI*

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Appeal 2008-1308  
Application 10/764,917  
Technology Center 3600

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Decided: September 8, 2008

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Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

**DECISION ON APPEAL**

**STATEMENT OF THE CASE**

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-14. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We REVERSE.

**THE INVENTION**

The Appellant's claimed invention is directed to a vending machine system with a card reader and a biometric scanner. The customer inserts an

identification card containing digital data corresponding to the biometric data of the customer. The customer also is subjected to a biometric scan at the vending machine. If both sets of biometric data match, the vending machine is enabled and the customer is vended the product. (Spec. 4-5). Claim 1, reproduced below, is representative of the subject matter of appeal.

1. A method of permitting only authorized users to use an automated vending machine, comprising the steps of:

providing each of the authorized users with an identification card that contains a digital data code corresponding both to the identity of the authorized user and a biometric characteristic of the authorized user;

providing a vending machine having an identification card reading device and a biometric characteristic scanner;

reading said digital data code from an identification card inserted into said identification card reading device in said vending machine by a potential user;

scanning an actual biometric characteristic directly from the potential user using said biometric characteristic scanner;

comparing the actual biometric characteristic of the potential user to the digital data code of said biometric characteristic contained on said identification card; and

enabling the vending machine if the actual biometric characteristic of the potential user matches the digital data code of said biometric characteristic contained

on said identification card and if said digital data code on said identification card indicates that the potential user is authorized.

### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Seeley US 6,615,191 B1 Sep. 2, 2003

The following rejections are before us for review:

1. Claims 1-14 are rejected under 35 U.S.C. § 102(e) as anticipated by Seeley.

### FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence<sup>1</sup>:

- FF1. Seeley discloses a software distribution and licensing system in which the software may be distributed by vending machines (col. 6:32-47).
- FF2. Seeley discloses an embodiment in which the registration interface, biometric interface, match detector, and music player can all be located on a single machine such as a specially modified computer (col. 8:46-51).
- FF3. Seeley fails to disclose that the software may be vended at a vending machine only after a match between identification card biometric data and

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<sup>1</sup> See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

that obtained from a biometric scanner at the vending machine (col. 8:41-51).

#### PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

#### ANALYSIS

The Appellant argues that the rejection of claim 1 under 35 U.S.C. § 102(e) is improper because in Seeley the vending machine only registers biometric data of the person purchasing the software and because the system does not use a biometric comparison to activate the vending machine (Br. 7). The Appellant argues that Seely does not disclose a system where a vending machine is enabled only if an actual biometric characteristic of a potential user matches the digital data code of a biometric characteristic contained on an identification card read by the vending machine (Br. 7).

In contrast the Examiner takes the position that Seely teaches that the vending machine and software player can be located in a single machine (Ans. 6-7). The Examiner has determined that since the registration and verification steps can be done at a single location the claims are therefore anticipated (Ans. 7).

We agree with the Appellant. We first construe the meaning of the word “vending machine” as used by the Appellant in the claims. We determine the scope of the claims in patent applications “not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc) (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004)). The Specification refers to known vending systems including ticket kiosks and automated order dispensing systems at a pharmacy (Spec. 6:13-18). The Specification also states that “the present invention can be embodied in many other forms, depending on the shape, size, and configuration of the product being vended” (Spec. 6:20-25). Giving the claims their broadest reasonable construction in light of the specification, the term “vending machine” would be construed by one of ordinary skill in the art to define vending machines where a product with a “shape, size, and configuration” existed as the specification describes. Seely discloses that a single machine, such as a personal computer, may include a match detector (FF2). Seely’s disclosure referred to by the Examiner as disclosing a “vending machine” (col. 8:46-51) only refers to a “single machine such as specially modified personal computer”. As a personal computer fails to dispense a product with an actual “shape, size, or

configuration” it cannot be construed to be a “vending machine” when the claims are given their broadest reasonable interpretation in light of the specification. As such, Seeley fails to disclose that the software may be vended at a “vending machine” only after a match between identification card biometric data and that obtained from a biometric scanner at a vending machine (FF3) and the claim is not anticipated. For the above reasons we will not sustain the rejection of claim 1 under 35 U.S.C. § 102(e) as anticipated by Seely.

The Appellant argues that claims 7 and 11 require a vending machine that can only be enabled upon comparing card data to an actual biometric scan performed at the vending machine (Br. 8-9). For the reasons given above, Seely fails to disclose such a feature in a vending machine. Accordingly, for the reasons given above, the rejection of claims 7 and 11 is not sustained.

The rejection of dependent claims 2-6, 8-10, and 12-14 does not cure the deficiency of the rejection of independent claims 1, 7, and 11 and the rejection of these claims is accordingly not sustained as well.

#### CONCLUSIONS OF LAW

We conclude that the Appellant has shown that the Examiner erred in rejecting claims 1-14 under 35 U.S.C. § 102(e) as being anticipated by Seely.

#### DECISON

The Examiner’s rejection of claims 1-14 is not sustained.

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REVERSED

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